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**MAILED**

JUL 26 2010

**OFFICE OF PETITIONS**

In re Application of :  
Nishimura, et al. :  
Application No. 10/566,593 : ON APPLICATION FOR  
Filed: August 17, 2006 : PATENT TERM ADJUSTMENT  
Atty Docket No. SHO-028US :  
:

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 CFR § 1.705(b), filed April 27, 2010. Applicants submit that the patent term adjustment to be indicated on the patent is six hundred forty-five (645) days, not four hundred sixteen (416) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction partly on the basis that the Office will take in excess of three years to issue this patent<sup>1</sup>.

In addition, applicants disclose that after applicants filed a reply on September 21, 2009 to a non-final Office action, that applicants submitted a supplemental reply or paper in the form of an Information Disclosure Statement (IDS) on January 22, 2010. Thus, applicants assert that a period of reduction of 123 days for applicant delay should be entered in connection with the filing of the IDS on January 22, 2010 pursuant to 37 CFR 1.704(c)(8).

To the extent that applicants request reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the

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<sup>1</sup> Applicants reference August 17, 2006 as the filing date upon which the 37 CFR 1.702(b) calculation is to be made. See p.2, Statement under 37 CFR § 1.705(b)(2). Applicants are informed that the over three year delay will, in this instance, be calculated based on the application commencement date, which is not August 17, 2006, but rather January 31, 2006. See 35 U.S.C. 371(b).

application for patent term adjustment under 37 CFR 1.705(b) is  
DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued. Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>2</sup>.

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<sup>2</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

To the extent that applicants otherwise request correction of the initial determination of patent term adjustment (PTA), the application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment determination at the time of the mailing of the Notice of Allowance is two hundred ninety-three (293) days. A copy of the updated PALM screen, showing the determination, is enclosed.

On January 27, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 416 days.

In the present petition applicants disclose that after applicants filed a reply on September 21, 2009 to a non-final Office action, that applicants submitted a supplemental reply or paper in the form of an Information Disclosure Statement (IDS) on January 22, 2010. The record does not support a conclusion that the examiner expressly requested the filing of the IDS. Further, a review of the IDS, filed January 22, 2010, reveals that applicants did not include a statement under 37 CFR 1.704(d).<sup>3</sup>

Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application. The patent term adjustment should have been reduced by 123 days pursuant to 37 CFR 1.704(c)(8), counting the number of days beginning on the day after the date the initial reply was filed, September 22, 2009, and ending on the date that the IDS was filed, January 22,

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<sup>3</sup> Pursuant to 37 CFR § 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

2010. Accordingly, a period of reduction of 123 days will be entered.

In view thereof, the determination of patent term adjustment at the time of mailing of the Notice of Allowance is **293 days** (447 days of Office delay - 154 (31 + 123) days of applicant delay).

The Office acknowledges receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Shirene Willis Brantley at (571) 272-3230.



Anthony Knight  
Director  
Office of Petitions

Enclosure: Copy of adjusted PALM calculation

# PALM INTRANET

Day : Friday  
Date: 7/23/2010

Time: 13:13:25

## PTA Calculations for Application: 10/566593

Application Filing Date:	08/17/2006	PTO Delay (PTO):	447
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	31
Post-Issue Petitions:	0	Total PTA (days):	293
PTO Delay Adjustment:	-123		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
71	07/23/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		123	
52	01/27/2010	MAIL NOTICE OF ALLOWANCE	6		37
51	01/25/2010	ISSUE REVISION COMPLETED			
50	01/22/2010	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
49	01/19/2010	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
48	01/19/2010	DOCUMENT VERIFICATION			
47	01/19/2010	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
46	01/19/2010	CASE DOCKETED TO EXAMINER IN GAU			
45	01/08/2010	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
44	01/19/2010	EXAMINER'S AMENDMENT COMMUNICATION			
43	01/19/2010	NOTICE OF ALLOWABILITY			
42	01/11/2010	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
41	01/04/2010	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
40	11/27/2009	FILING RECEIPT - CORRECTED			
39	09/21/2009	NEW OR ADDITIONAL DRAWING FILED			
38	11/03/2009	DATE FORWARDED TO EXAMINER			
37	09/21/2009	RESPONSE AFTER NON-FINAL ACTION		31	34
36	09/21/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
35	10/01/2009	FILING RECEIPT - CORRECTED			
34	05/21/2009	MAIL NON-FINAL REJECTION			
33	05/21/2009	NON-FINAL REJECTION			

29	12/11/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
28	03/11/2009	DATE FORWARDED TO EXAMINER			
27	01/29/2009	RESPONSE TO ELECTION / RESTRICTION FILED			
26	12/31/2008	MAIL RESTRICTION REQUIREMENT	441		12
25	12/24/2008	REQUIREMENT FOR RESTRICTION / ELECTION			
24	01/16/2008	MISCELLANEOUS INCOMING LETTER			
23	09/05/2007	CORRESPONDENCE ADDRESS CHANGE			
22	08/09/2007	PG-PUB ISSUE NOTIFICATION			
21	06/29/2007	CASE DOCKETED TO EXAMINER IN GAU			
20	12/11/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	05/25/2007	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
17	08/17/2006	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
15	12/11/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
13	05/15/2007	APPLICATION DISPATCHED FROM OIPE			
12	08/17/2006	371 COMPLETION DATE			
11	05/08/2007	SENT TO CLASSIFICATION CONTRACTOR			
10	05/08/2007	NOTICE OF DO/EO ACCEPTANCE MAILED			
9	08/17/2006	ADDITIONAL APPLICATION FILING FEES			
6	08/17/2006	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			

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#### EXPLANATION OF PTA CALCULATION

#### EXPLANATION OF PTE CALCULATION

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